



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,145	09/21/2005	Anne T. Bruinvels	BJS-620-390	7778

23117 7590 03/20/2007
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER

MACFARLANE, STACEY NEE

ART UNIT	PAPER NUMBER
----------	--------------

1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/550,145

Applicant(s)

BRUINVELS, ANNE T.

Examiner

Stacey MacFarlane

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 20-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 20-24, drawn to a method for determining candidate compounds having affinity for the 5-HT_{2C} receptor for use as a treatment of schizophrenia, suicidality or mild cognitive impairment.

Group 2, claim(s) 25, 26 and 47-51, drawn to a therapeutic product comprising a 5-HT_{2C} receptor antagonist **and** a typical anti-psychotic for treatment of schizophrenia, suicidality or mild cognitive impairment.

Group 3, claim(s) 27-46, drawn to a method for treating patients suffering from schizophrenia, suicidality or mild cognitive impairment, with a 5-HT_{2C} receptor antagonist.

The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature that permeates the groups is a compound that binds to the 5-HT_{2C} receptor and treats the symptoms of schizophrenia, suicidality or mild cognitive impairment. The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions makes over the prior art. Whether a particular feature makes a contribution over the prior art, is

Art Unit: 1609

considered with respect to novelty and inventive step. In the instant application, the common technical feature among the groups, a compound that binds to the 5-HT_{2C} receptor and treats the symptoms of schizophrenia, suicidality or mild cognitive impairment, is taught by the following prior art (U.S. Patent number 6699852, filed December 19, 2001). The prior art teaches tetracyclic pyridoindoles as compounds that demonstrate affinity for the 5-HT_{2C} receptor and discloses their use for the treatment of negative symptoms of schizophrenia. The prior art recites the common technical feature of Groups 1-3, without the compounds of the prior art being specifically excluded in the proviso of the claims. Thus, there is no special technical feature over the prior art and the application lacks Unity of Invention under PCT Rule 13.1.

Species Election

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

(Claims 20 and 21) Elect a **single** affinity value for **each** of variables A and B from the list of Claim 21.

(Claims 27-46) Elect **one** condition for treatment: schizophrenia, suicidality, or mild cognitive impairment.

(Claims 33, 34, 35, 36, 43, 44, 45, 46, 48, 49, 50, 51) Elect a **single** 5-HT_{2C} receptor antagonist from the following compounds: AHR-16303B (AH Robins Co. Inc), AP-792 (Ajinomoto Co. Inc.), AT-1015 (Ajinomoto Co. Inc.), BMS-181102 (Bristol Myers Squibb), CV-5197 (Takeda Chemical Industries Ltd), dotarizine (Ferrer Internacional SA), E-2101 (Eisai Co Ltd), eltoprazine (Solvay SA), emopamil (Knoll AG), HT-90B (Chugai Pharmaceutical Co Ltd), ICI-169369 (Zeneca Group plc), IC1-170809 (Zeneca Group plc), LU-26042 (H Lundbeck A/S), LU-29066 (H Lundbeck A/S), NPC-18166 (Scios Inc), Org-38457 (NV Organon), pelanserin (Cinvestav), perbufylline (Siegfried Group), SB-206553 (SmithKline Beecham), SB-242084 (SmithKline Beecham), SR-46615A (Sanofi Recherche SA), SUN-9221 (Suntory Ltd) tropoxin (Russian Academy Medical Science), YM-992 (Yamanouchi Pharmaceutical Co Ltd), Ro-60-0759, RS-102221, SDZ-SER-082, IC1-169369, deramciclane, N-desmethyl-deramciclane, amesergide, sergolexole, CGS-18102A, LU-26042, ritanserin, clozapine, fluperlapine, loxapine, ORG-5222, pipamperone, sertindole, olanzapine, zotepine, or ziprasidone.

4. It is noted that claims 32, 42 and 47 set forth compounds, which are alternative to those listed above, by reference to publications other than US patents and US patent application publications. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper (See claims 32, 42

and 47). Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). **If applicant wishes to prosecute any of the species disclosed in the cited publications, those species must be recited in the claim, and the specific compound must be identified for initial prosecution.**

5. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or

Art Unit: 1609

corresponding special technical features for the following reasons. The PCT rules provide for the examination of the first claimed product, the first claimed method of making that product, and the first claimed method of using that product in one application, but do not provide for the examination of multiple products or unrelated methods. The multiple species of compounds differ in structure and biological function, and in addition to the different disorders listed, may exhibit different effects, functions and outcomes. Thus, the species are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not

Art Unit: 1609

commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

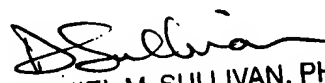
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacey MacFarlane whose telephone number is (571) 270-3057. The examiner can normally be reached on Monday-Thursday 6:30AM-4:00 PM & ALT. Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Mosher can be reached on (571) 272-0906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DANIEL M. SULLIVAN, PH.D.
PRIMARY EXAMINER